

## REMARKS

In the Office Action, the drawings were objected to under 37 C.F.R. 1.83(a), for failing to show every feature of the invention specified in the claims; claim 8 was objected to for improper dependent form; claim 21 was rejected under claims 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement; claims 1-9 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dwek (USPN 6,248,946); claims 10, 11, 13, 14, 17, 18, 20, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dwek in view of Leeke et al. (USPN 6,587,127), and in further view of Eyal (USPN 6389467); claims 12 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of Leeke and Eyal and further in view of Martino (USPN 5,987,103); claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of Leeke and Eyal and further in view of Ten Kate. (USPN 6,601,237). In an unusual and simultaneous second office action, claims 1 - 5, 8, 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by simply “Liu”; claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu in view of Leeke; claims 10, 11, 13, 14, 17, 18, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu in view of Leeke and further in view of Eyal; claims 12 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu, Leeke, and Eyal as applied to claims 10 and 11 and further in view of Martino; claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu, Leeke, and Eyal as applied to claims 10 and 13 and further in view of Ten Kate. The Applicant traverses each of the Examiner’s §§ 102 and 103 rejections and maintains that all pending claims are in allowable form. The Applicant cannot properly respond to the Liu reference. Based on the previous Office Action, the Applicant can only assume that “Liu” is supposed to mean USPN 5,953,005.

Addressing the Examiner’s first Office Action, the Applicant has withdrawn claim 21 to address the Examiner’s objection to the drawings and, thereby, addressing the Examiner’s § 112 rejection. The Applicant has also canceled claim 8 to address the Examiner’s objection thereto.

Regarding Dwek and Eyal, as stated previously, on November 3, 2003, the Applicant submitted a 37 CFR § 1.131 declaration (the “declaration”) swearing behind

Eyal. This declaration was filed with a Request for Continued Examination (RCE). In response, the Examiner (Mr. David England) stated that the “Applicant’s arguments with respect to claims 1 - 19 have been considered but are moot in view the new ground(s) of rejection”. Since no amendments were made to the claims when the RCE was filed (i.e., no amendments in the Final Office Action Response dated Sept. 4, 2003 or in the RCE dated Nov. 3, 2003), the Examiner’s next Office Action clearly leads one to believe that the declaration was effective in removing Eyal as a reference.

Now, however, the Examiner (Mr. David England) is stating that the declaration is ineffective so that the Examiner may reinstate Eyal as prior art. If the declaration was ineffective, there should have been no new grounds for rejection in the Office Action dated Jun. 18, 2004 (item 42 of the Office Action) and the Examiner should have again finally rejected the claims. *See e.g.*, MPEP § 7.41. In other words, the Examiner would not need additional art to reject the claims if the declaration was ineffective. If the declaration was ineffective, the Examiner should have stated so in the following office action – not three office actions later. The Applicant reminds the Examiner that his examination must be complete and that the Examiner shall make a thorough study and investigation of the available prior art relating to the subject matter of the claimed invention. 37 CFR §1.104; *see also*, MPEP § 700. By stating now that the declaration is ineffective, the Examiner is, in effect, stating that the examination was not complete and that thorough study was not made in the Jun. 18, 2004 Office Action.

The present application has seen two RCEs and now faces a third. This “cat and mouse” examination has cost the Applicant great expense and has unreasonably delayed the issuance of the Applicant’s patentable claims. In the hopes of advancing prosecution, the Applicant, in the last Office Action response, substantially narrowed the claims and provided further reasons as to why the Applicant’s claims patentably distinguish from the cited references.

The Applicant maintains that the declaration is not only effective at removing Eyal as a prior art reference but it is also effective at removing Dwek as a prior art reference. The Applicant reminds the Examiner that diligence need only be established with “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date … to the filing of the application.” *See* 37 C.F.R. §

1.131. The present application has a filing date of March 2, 2000. Dwek has a filing date of March 1, 2000 and Eyal has an effective filing date of January 24, 2000. Accordingly, the Applicant need only establish diligence prior to March 1, 2000 for Dwek and January 24, 2000 for Eyal. In the declaration, the Applicant's patent attorney, Mr. Kenneth J. Johnson, prepared a patent application on December 28, 1999, a date that is prior to both Dwek and Eyal and clearly visible in the correspondence to the inventor. From that time to the date of filing, Mr. Johnson stated that he received feedback from the inventors about the patent application in January or early February 2000 (item 6 of the declaration), made corrections thereto on February 9, 2000 (item 7), prepared formal documents from February 21, 2000 (item 8), received the formal documents from the inventors on February 28, 2000 (item 9) and filed the application on March 2, 2000. The correspondence illustrating these facts was attached as evidence with the submission of the declaration. The Examiner stated that there is "almost a year for the last known correspondence to the filing of the Applicant's Application. The last correspondence from Mr. Johnson to the inventor prior to the filing of the patent application is, in fact, only 10 days. The Examiner's statement is so thoroughly incorrect that it suggests that the Examiner did not even review the declaration. The Applicant maintains that the declaration coupled with the associated evidence fully establishes diligence from December 28, 1999 (i.e., prior to the two referenced filing dates) through the filing of the present application on March 2, 2000 (i.e., period of just over 2 months).

The Examiner also stated that the "Applicant has not in anyway proved that the teachings in the information filed in the declaration under 37 C.F.R. § 1.131 teaches what is stated in their claim language as stated now nor is there any comparison to what was taught by the Applicant in said documents, just mere allegations". The Applicant respectfully disagrees and submits that the Examiner statement is nothing more than "just mere allegations".

As but one example of the claims being supported by the invention disclosure form submitted with the Applicant's declaration, the Applicant recites a system for automatically retrieving and playing multimedia files in claim 1. The system includes a network access interface through which access to a data network may be attained. The system also includes a processing module that is configured to search the data network

for a multimedia file and to return information including an identifier of that multimedia file, a location of that multimedia file and datum relating to a schedule of the availability of that multimedia file. The processing module is further configured to categorize the multimedia file and create categorization information relating to the multimedia file. The system also includes a selection interface in communication with said processing module which provides for presentation of the returned information, and is configured to receive and process a selection for accessing a selected multimedia file from the data network and compile a download schedule and a file download device in communication with the selection interface which, based on the download schedule, automatically accesses said first multimedia file at said location through said network access interface and downloads the selected multimedia file. This claim is thoroughly supported by the Applicant's information disclosure form on pages 1 -5. For example, the Applicant on page 3 recites "a piece of software running at the centralized web site" (e.g., a processing module) "will organize the data received from the web sites by category into another read only HTML file". The Applicant also discloses on page 3 "a program guide" (e.g., a selection interface) ", along with two selection buttons for each program". The Applicant also discloses "the player" (e.g., a file download service) "will be launched receive the program on the desktop", on pages 4 and 5. The Applicants information disclosure form is "chock-full" of additional support that one skilled in the art would find useful in constructing the claimed invention should that person simply read the Applicant's information disclosure form.

There is no requirement that every word in a claim must be identical to that disclosed in an information disclosure form. The only requirement must be that one skilled in the art would know how to make and use the invention without undue experimentation upon reading information disclosure form. Patent practitioners have always maintained "religious freedom" when capturing an invention with claim language. The Applicant maintains that the Applicant's rather substantive information disclosure form (e.g., 6 pages of text) fully supports the chosen claim language and that one skilled in the art would be able to make and use the invention without undue experimentation. Accordingly, the Applicant's arguments regarding either Dwek or Eyal of previous office actions stand and the Applicant maintains that all pending claims are novel and

nonobvious in view of the cited references. For at least the reasons stated herein, the Applicant respectfully requests reconsideration and allowance of the Applicant's claims in view of Dwek and/or Eyal, either alone or in combination with any of the cited references. Should the Examiner deem the Applicant's arguments not persuasive, the Applicant respectfully requests a quick response so that the Applicant may address the appealable issues cited herein. In the alternative, the Applicant requests a new Non Final Office Action to address the Examiner's newly entered objections to the declaration.

Regarding the "second" Office Action mailed March 13, 2006, along with the "first" Office Action mailed the same date, the Applicant need only address the rejections associated with claims 1 - 5, 8, and 9 since all of the remaining rejections rely on Eyal, which is not prior art based on the § 1.131 declaration. The Examiner rejected claims 1 - 5, 8, and 9 under § 102(e) as being anticipated by "Liu". However, the Examiner failed to properly cite the reference by including, for example, the number and date, and name of the patentee. *See e.g.*, 37 CFR § 1.104; *see also*, MPEP § 707.05. A simple search of the Patent Office patent database reveals that there are 8976 patents having inventors with the name of Liu. The Applicant surely cannot be expected to search all of these patents to understand the applicability of Liu to this office action. The Applicant will attempt to address the "Liu" reference mentioned in the previous Non Final Office Action, even though that reference itself was not properly cited in a PTO form 892. However, if the Examiner deems the Applicant's arguments not persuasive, the Applicant demands a new office action to properly address the "Liu" reference.

Regarding Liu, the Applicant recites a system for automatically retrieving and playing multimedia files that includes a network access interface through which access to a data network may be attained. The system also includes a processing module configured to search the data network for a first multimedia file and to return information including an identifier of the first multimedia file, a first location of the first multimedia file and a first datum relating to a first schedule of the availability of the first multimedia file, wherein the processing module is further configured to categorize the first multimedia file and create first categorization information relating to the first multimedia file. The processing module is also configured to search the data network for a second multimedia file and to return information including a second identifier of the second

multimedia file, a second location of the second multimedia file and a second datum relating to a second schedule of the availability of the second multimedia file, wherein the processing module is further configured to categorize the second multimedia file and create second categorization information relating to the second multimedia file. The processing module, the first location, and the second location are situated within distinct domains within the data network. The system further includes a selection interface in communication with the processing module which provides for presentation of the returned information, and is configured to receive and process a selection for accessing a selected multimedia file from the data network and compile a download schedule and a file download device in communication with the selection interface which, based on the download schedule, automatically accesses the first multimedia file at the location through the network access interface and downloads the selected multimedia file.

The Examiner states that Liu teaches a processing module that is configured to search the data network for a first multimedia file and to return information including an identifier of the first multimedia file, a first location of the first multimedia file and a first datum relating to a first schedule of the availability of the first multimedia file, wherein the processing module is further configured to categorize the first multimedia file and create first categorization information relating to the first multimedia file at column 6, line 28 - column 7, line 3. Here, Liu teaches an online karaoke system from which a user may select songs. Nowhere in this reference, however, does Liu teach any type of scheduling for the availability of a multimedia file. In fact, Liu does not once use any form of the word schedule. Nor does Liu teach searching a data network for a multimedia file, let alone returning information pertaining to location of a multimedia file. As such, Liu does not teach that which the Applicant claims.

The Examiner also states that Liu teaches that the processing module is configured to search the data network for a second multimedia file and to return information including a second identifier of the second multimedia file, a second location of the second multimedia file and a second datum relating to a second schedule of the availability of the second multimedia file, wherein the processing module is further configured to categorize the second multimedia file and create second categorization information relating to the second multimedia file at column 6, line 28 - column 7, line 3.

As stated, Liu does not scheduling, searching, or returning information. As such, Liu does not teach that which the Applicant claims.

The Examiner further states that Liu teaches that the processing module, the first location, and the second location are situated within distinct domains within the data network at column 6, line 28 - column 7, line 3. The Applicant respectfully disagrees. Here, Liu again teaches an online karaoke system from which a user can access songs. Not once at this reference does Liu teach or even reasonably suggest separate locations for songs and/or processing. More likely, Liu teaches a centralized database (e.g., main database server 72 of Liu) that a user can access through a user interface. Assuming that any processing does go on, it is likely that the processing would be located with the centralized database. Since Liu does not teach distinct locations for multimedia files and processing, Liu does not teach that which the Applicant claims. For at least these reasons, claim 1 is novel over Liu. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 1.

Claims 2 - 7 and 9 depend from claim 1 and inherit all of the novel features of the independent claim. Accordingly, these claims are also novel over Liu. These claims, however, recite additional subject matter that further distinguish from Liu. For example, claim 2 recites a centralized location on the data network employable to search the data network for the second multimedia file, receive information including the second identifier of the second multimedia file, the second location of the second multimedia file, the second datum relating to the second schedule of availability of the second multimedia file and the second categorization information relating to the second multimedia file, and provide the second categorization information to the processing module. As stated in claim 1, Liu does not teach any type of scheduling or searching. Accordingly, Liu does not teach that which the Applicant claims in claim 2. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 2.

As another example of patentable distinction, Claim 7 recites that an interface is provided for restricting categories of multimedia files to be presented at the selection interface. The Examiner states that such is taught by Liu in view of Leeke in a § 103(a) rejection. The Applicant respectfully disagrees. First, the Examiner incorrectly stated the Applicant's claim by stating that "Liu teaches an interface is provided for selecting

from which the listing is created ..., but does not specifically keep selecting categories.” Again, the claimed interface provides for restricting categories - not selecting. Regardless, Leeke’s only use of the word restrict regards providing *unrestricted* access at column 14, lines 14 - 29. Leeke, in fact, teaches away from the Applicant claims. Since Liu also does not teach *restricting* access, the combination of Liu with Leeke does not teach all of the elements of the Applicant’s claim. For at least these reasons, claim 7 is novel and nonobvious review of the cited references, either alone or in combination. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 7.

### CONCLUSION

Based upon the foregoing, the Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

MARSH FISCHMANN & BREYFOGLE LLP

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By:

Gregory T. Fettig  
Registration No. 50,843  
3151 South Vaughn Way, Suite 411  
Aurora, Colorado 80014  
Telephone: (720) 562-5509  
Facsimile: (720) 406-0520